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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,213	03/30/2004	Nicolas Deloge	OSTEONICS 3.0-455	4051
530 7590 12/23/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER COMSTOCK, DAVID C	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 12/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/813,213	Applicant(s) DELOGE ET AL.	
	Examiner DAVID COMSTOCK	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/20/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06 October 2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin et al. (7,207,993).

Baldwin et al. disclose a device for repairing a femur comprising a bracket 300 with a portion that extends along a femur and a portion that extends over a proximal region of a greater trochanter (see, e.g., Fig. 10). Adjustable securing means 705 extend through guides in the bracket. The device comprises a threaded securing screw 350 and the securing means comprise elongate flexible cable ties or bands. Baldwin et

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al. disclose the claimed invention except for explicitly reciting that the bracket could comprise separate arms (i.e. split open bifurcated) or that the device could be formed of a resilient material such as a plastic material. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the bracket in two sections or arms, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. It also would have been obvious to have formed the device from any of various known materials, including for example plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Moreover, it would have been further obvious to have located the split section at any desired location on the device, including, for example, intermediate first and second sides of the first portion, since it has been held that mere relocation of features of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claims 11, 12 and 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin et al. (7,207,993), as applied to claims 1 and 13 above, and further in view of Harwin (5,163,961)

Baldwin et al., as modified, disclose the claimed invention except for explicitly reciting that the screw could be secured to a threaded hole in an end of a femoral implant. Harwin discloses a femoral implant and teaches that a trochanteric region can be secured to a threaded hole in an end of a femoral implant by a screw 9, in order to

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securely retain the bone in position and reduce the chance of the procedure failing (see, e.g., Fig. 1 and col. 1, lines 8-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the device of Baldwin, as modified, with a screw passing into an end of a femoral prosthesis, in view of Harwin, in order to securely retain the bone in position and reduce the chance of the procedure failing.

Claims 1-4, 6-10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Getscher et al. (3,824,995) in view of Barnes (5,941,881)

Getscher et al. disclose a trochanteric prosthesis comprising a bracket 10 having a portion extending along a femur and a portion 24 extending over a proximal end of a trochanteric region (see, e.g., Fig. 1). The device comprises a free end, e.g., extending from the offset portion 16. The free end comprises a bifurcation (i.e. "split open" section). The device is formed of thin stainless steel, which is resilient (col. 2, lines 42-44). Getscher et al. disclose the claimed invention except for explicitly reciting that the device can be secured with any of various securing means such as cables, clamps, screws, etc., as disclosed by Barnes (see col. 2, lines 65-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted cables, or the like, for the screws in Getscher et al., or to have used screws to secure the proximal end, in view of Barnes, as this would have amounted to nothing more than the substitution of functionally equivalent securing means known in the art at the time of the invention. It also would have been obvious to have located the split section at any desired location on the device, including, for example, intermediate

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first and second sides of the first portion, since it has been held that mere relocation of features of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claims 11, 12 and 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Getscher et al. (3,824,995) in view of Barnes (5,941,881), as applied to claims 1 and 13 above, and further in view of Harwin (5,163,961).

The device of the combination of Getscher et al. and Barnes discloses the claimed invention except for explicitly reciting that the device could be secured to a threaded hole in an end of a femoral prosthesis by a screw. Harwin discloses using a femoral implant and teaches that a trochanteric region can be secured to a threaded hole in an end of a femoral implant by a screw 9, in order to securely retain the bone in position and reduce the chance of the procedure failing (see, e.g., Fig. 1 and col. 1, lines 8-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the device of Getscher and Barnes, with a screw passing into an end of a femoral prosthesis, in view of Harwin, in order to securely retain the bone in position and reduce the chance of the procedure failing.

Response to Arguments

Applicant's arguments filed 06 October 2008 have been considered but are not persuasive.

It is noted that the upper portion (i.e. that portion of the guide above the apertures can be considered as an "outwardly extending section" of the bracket, etc., as claimed, since, at least relative to the central and opposing portions, it is "outwardly

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extending.” As such, the securing means also extends in an appropriate location, in accordance with the amended claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DC/

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733